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EXAMINER

ELAHEE, MD S

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,151

Applicant(s)

ROUSE ET AL.

Examiner

Md S. Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34, 36-45 and 47-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34, 36-45 and 47-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 09/28/2006. Claims 1-34, 36-45 and 47-62 are pending.

Response to Arguments

2. Applicant's arguments filed on 09/28/2006 Remarks are not persuasive because of the following:

Regarding claims 1, 9, 17, 25 and 53, the applicant argues on page 14, lines 1-5 that **Montlick** fails to anticipate "providing a form application associated with the selected form to format display of the transmissible media content according to the selected form". Examiner respectfully disagrees with this argument. In claim 8, the applicant claim that the form application comprises at least one form and at least one related subform. **Montlick** teaches that the form application comprises at least one form (fig.3,3a,6, item 32) and at least one subform (fig.7B, item 78). Thus **Montlick** teaches providing a form application (fig.3,3a,6, item 32 and fig.7B, item 78) associated with the selected form to format display of the transmissible media content according to the selected form (col.2, lines 63-67, col.3, lines 1-13, 23-31, col.5, lines 55-61, col.8, lines 10-20, 65-67, col.9, lines 1-10). Thus the rejection of the claim in view of **Montlick** will remain.

3. With respect to the 35 USC 103 rejections, Examiner respectfully disagrees with the 09/28/2006 Remarks for the following reasons:

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Regarding claims 1, 9, 17, 25 and 53, the applicant argues on pages 14-15 that **Stiulz** fails to disclose, teach or suggest “enabling selection...of at least one form from the plurality of different forms for displaying the transmissible media content”. Examiner respectfully disagrees with this argument. In claim 8, the applicant claim that the form application comprises at least one form and at least one related subform. In figure on page 544 and description under “Create New Message (Outbox)” on pages 544-545, **Stiulz** teaches enabling selection, on the PC of at least one form from the plurality of different forms for displaying the transmissible media content. Thus the rejection of the claim in view of **Stiulz** and **Kumar** will remain.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-34, 36-39, 41-45, 47-49, 51-57, 59, 60 and 62 are rejected as best understood in light of the 112, first and second paragraph problem under 35 U.S.C. 102(b) as being anticipated by **Montlick** (U.S. Patent No. 5,561,446).

Regarding claims 1 and 25, with respect to fig.1,3-4,6,7 **Montlick** teaches a method of formatting a document that includes transmissible media content based on input generated at a wireless client device, the document formatted for display to include one or more fields corresponding to portions of the transmissible media content, the method comprising:

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enabling a user to select the one or more fields corresponding to the portions of content of page (item 50, fig.3,3a) [i.e., transmissible media content] (fig.3,3a,6, item 32);

presenting a plurality of different forms (fig.3,3a,6, item 32) comprising:

a full form (physical-John Q Public, ID# 123456789 9/2/93, fig.3a) used to format the display of the transmission media content according to all of the fields (items 51,52,53 of fig.3a) for displaying all of the content of page 50 [i.e., transmissible media content] (fig.3,3a,6, item 32; col.8, lines 10-20, 65-67, col.9, lines 1-10); (Note: the claimed limitation recites “**for**” performing a function of “displaying”. The claim only requires the method of ability to perform such “display” without requiring that feature actually be performed.)

a brief form (item 54, fig.4) used to format the display of the transmission media content according to the user selected one or more of fields (items 52, 53 of fig.4) corresponding to the portions of the content of page 50 [i.e., transmissible media content] wherein the user selected fields are less than all the available fields (col.8, lines 33-58, 65-67, col.9, lines 1-10, 22-25); (Note: form **physical-John Q Public, ID# 123456789 9/2/93** has multiple fields 51, 52 and 53 and **electronic ink file 54** has fields 52 and 52 which are selected fields of form **physical-John Q Public, ID# 123456789 9/2/93**. Therefore, form **physical-John Q Public, ID# 123456789 9/2/93** is a full form and **electronic ink file 54** is a brief form.)

enabling selection, on the wireless client device of at least one form from the plurality of different forms for displaying the transmissible media content (fig.3,3a,6, item 32; col.2, lines 63-67, col.3, lines 1-13, col.8, lines 10-20, 65-67, col.9, lines 1-10);

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providing a form application associated with the selected form to format display of the transmissible media content according to the selected form (col.2, lines 63-67, col.3, lines 1-13, 23-31, col.5, lines 55-61, col.8, lines 10-20, 65-67, col.9, lines 1-10);

transmitting the formatted transmissible media content via a wireless medium (fig.1; col.10, lines 2-4).

Regarding claims 2, 10, 18, 26, 42 and 52, **Montlick** teaches enabling selection at least one of the brief form option, the full form option, a create form option, a modify form option, a delete form option, a forward form option, a fax form option, and a send form option (fig.3,3a,6, item 32).

Regarding claims 3, 11, 19 and 27, **Montlick** teaches communicating via at least one of a wireless connection (i.e., Bluetooth protocol, a Wireless Application protocol, a Global System Mobile protocol, and a Wireless Markup Language protocol) (fig.1; col.10, lines 2-4).

Regarding claims 4, 12, 20 and 28, **Montlick** teaches presenting the transmissible media content to a user according to at least one displaying option (fig.3,3a,6, item 32).

Regarding claims 5, 13, 21 and 29, **Montlick** teaches that the presentation options comprises at least one of facsimile form, memorandum form, invitation form, and user profile form (fig.3,3a,6, item 32).

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Regarding claims 6, 14, 22 and 30, **Montlick** teaches that the transmissible media content comprises at least one of user data, address data, memo data, and search data (fig.6, item 70).

Regarding claims 7, 15, 23 and 31, **Montlick** teaches communicating the transmissible media content from a data source remote from the wireless client device (fig.1; col.10, lines 2-4).

Regarding claims 8, 16, 24 and 32, **Montlick** teaches that the form application comprises at least one form (fig.3,3a,6, item 32) and at least one subform (fig.7B, item 78).

Claims 9 and 17 are rejected for the same reasons as discussed above with respect to claim 1. Furthermore, **Montlick** teaches a display that displays a plurality of forms (fig.3,3a,6, item 32);

an input interface on the wireless client device that enables selection of at least one form for displaying the transmissible media content on the wireless client device (fig.3,3a,6, item 32);

a processor unit that provides a form application associated with the selected form to format display of the transmissible media content and transmits the formatted transmissible media content via a wireless medium (col.2, lines 63-67, col.3, lines 1-13, 23-31, col.5, lines 55-61, col.8, lines 10-20, 65-67, col.9, lines 1-10).

Regarding claims 33 and 43, **Montlick** teaches that the selecting at least one form comprises at least two predetermined fields (fig.3,3a,6, item 32).

Regarding claims 34 and 44, **Montlick** teaches that one or more of the at least two predetermined fields is automatically pre-filled (fig.6, item 32).

Regarding claim 36, **Montlick** teaches that each of the plurality of different forms is associated with at least one communication type (fig.1; col.10, lines 2-4).

Regarding claims 37 and 47, **Montlick** teaches that the step of enabling selection of at least one form, on the wireless client device, comprises enabling selection of a communication type from a plurality of different communication types (fig.1; col.10, lines 2-4).

Claims 38, 48 and 55 are rejected for the same reasons as discussed above with respect to claim 37. Furthermore, **Montlick** teaches enabling selection of a type of receiving terminal from a plurality of different types of receiving terminals (fig.1; col.10, lines 2-4).

Regarding claims 39, 49 and 54, **Montlick** teaches that one or more receiving terminals includes at least one of a facsimile, a computer terminal, and a wireless device terminal (col.10, lines 2-4).

Regarding claims 41 and 51, **Montlick** teaches creating a custom action associated with the selected at least one form option (fig.3,3a,6, item 32).

Regarding claim 45, **Montlick** teaches that the at least one form is selected by a user (fig.3,3a,6, item 32).

Claim 53 is rejected for the same reasons as discussed above with respect to claim 9. Furthermore, **Montlick** teaches at least one forms module that enables selection, on the wireless client device, of a form for displaying transmission media content, and provides a form application associated with the selected form that formats display of the transmissible media content, such that the user is enabled to create and edit a document (fig.3,3a,6, item 32; col.2, lines 63-67, col.3, lines 1-13, 23-31, col.5, lines 55-61, col.8, lines 10-20, 65-67, col.9, lines 1-10);

at least one communication module that communicates the document from the wireless client device to one or more receiving terminals (fig.1; col.10, lines 2-4).

Regarding claims 56 and 57, **Montlick** teaches that the at least one forms module includes pre-stored forms (fig.3,3a,6, item 32).

Regarding claim 59, **Montlick** teaches that the at least one forms module enables the user to specify a form type and a plurality of form properties of a custom form (fig.3,3a,6, item 32).

Claim 60 is rejected for the same reasons as discussed above with respect to claim 33. Furthermore, **Montlick** teaches that the first predetermined field includes content and the second predetermined field includes a action property, and wherein the selection option facilitates

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communication of the content of the first predetermined field to the one or more receiving terminals (fig.1,6,7; col.9, lines 41-58, col.10, lines 2-4, 12-15, 23-29).

Regarding claim 62, **Montlick** teaches that the action property is pre-stored in the second predetermined field (fig.6, item 72).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 40, 50 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Montlick** (U.S. Patent No. 5,561,446) in view of **Carlson et al.** (U.S. Patent No. 7,010,616).

Regarding claims 40, 50 and 58, **Montlick** does not specifically teach “the selected at least one form is a custom made form”. **Carlson** teaches that the selected at least one form is a custom made form (fig.30, item 2240; col.30, lines 4-18). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Montlick** to incorporate the selected at least one form being a custom made form as taught by **Carlson**. The motivation for the modification is to have doing so in order to provide a form with desired field.

10. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Montlick** (U.S. Patent No. 5,561,446) in view of **Wagner et al.** (U.S. Patent No. 6,169,911).

Regarding claim 61, **Montlick** does not specifically teach “the action property includes one of a Mail TO property and a Dial Phone property”. **Wagner** teaches that the selection option includes Go option (i.e., one of a Mail TO property and a Dial Phone property) (col.5, lines 21-30). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Montlick** to incorporate the action property including one of a Mail TO

property and a Dial Phone property as taught by **Wagner**. The motivation for the modification is to have doing so in order to provide voice and data communication for a user with different types of terminals.

11. Claims 1, 9, 17, 25 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Stultz** (Learn Microsoft Office 97, ISBN 1-55622-540-7) in view of **Kumar** (U.S. Pub. No. 2006/0105804).

Regarding claims 1 and 25, with respect to figure on page 544, **Stultz** teaches a method of formatting a document that includes transmissible media content based on input generated at a wireless client device, the document formatted for display to include one or more fields corresponding to portions of the transmissible media content, the method comprising:

enabling a user to select the one or more fields corresponding to portions of displaying the transmissible media content (figure on page 544; description under "Create New Message (Outbox)" on pages 544-545);

presenting a plurality of different forms (figure on page 544) comprising:

a full form (document of figure on page 544 with From field, To field, Cc field, Bcc field) used to format the display of the transmission media content according to all of the fields (From field, To field, Cc field, Bcc field and other fields on figure of page 544) for displaying all of the transmissible media content (figure on page 544); (Note: form **View** button of figure on page 544, a user can select **From field, Cc field, Bcc field**)

a brief form (document of figure on page 544 with selected any of From field, Cc field or Bcc field) used to format the display of the transmission media content according to the user selected one or more of fields (any of From field, Cc field or Bcc field) corresponding to the portions of the transmissible media content wherein the user selected fields are less than all the available fields (figure on page 544);

enabling selection, on the PC of at least one form from the plurality of different forms for displaying the transmissible media content (figure on page 544; description under "Create New Message (Outbox)" on pages 544-545);

providing an email or a fax application [i.e., a form application] associated with the selected form to format display of the transmissible media content according to the selected form (figure on page 544; description under "Create New Message (Outbox)" on pages 544-545);

transmitting the formatted transmissible media content (description under "Create New Message (Outbox)" on page 545).

However, **Stultz** does not specifically teach "a wireless client device" and "transmitting the formatted transmissible media content via a wireless medium". **Kumar** teaches a detachable handset [i.e., wireless client device] and transmitting the formatted transmissible media content via a wireless medium (fig.1, item 10; page 3, paragraph 0033). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Stultz** to incorporate a wireless client device and the feature of transmitting the formatted transmissible media content via a wireless medium as taught by **Kumar**. The motivation for the modification is to do so in order to send document using a detachable handset unit via wireless communication.

Claims 9 and 17 are rejected for the same reasons as discussed above with respect to claim 1. Furthermore, **Stultz** teaches a display that displays a plurality of forms (figure on page 544; description under “Create New Message (Outbox)” on pages 544-545);

an input interface on the PC that enables selection of at least one form for displaying the transmissible media content on the PC (figure on page 544; description under “Create New Message (Outbox)” on pages 544-545);

a processor unit that provides a form application associated with the selected form to format display of the transmissible media content and transmits the formatted transmissible media content (figure on page 544; description under “Create New Message (Outbox)” on pages 544-545).

Claim 53 is rejected for the same reasons as discussed above with respect to claim 9. Furthermore, **Stultz** teaches at least one forms module that enables selection, on the PC, of a form for displaying transmission media content, and provides a form application associated with the selected form that formats display of the transmissible media content, such that the user is enabled to create and edit a document (figure on page 544; description under “Create New Message (Outbox)” on pages 544-545);

at least one communication module that communicates the document from the PC to one or more receiving terminals (figure on page 544; description under “Create New Message (Outbox)” on pages 544-545).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chen et al. (U.S. 2002/0073235) teach System and method for content distillation.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ME

MD SHAFIUL ALAM ELAHEE

December 8, 2006



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